

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Customer Number: 20277
Yoshiaki NISHIBAYASHI, et al. : Confirmation Number: 1031
Application No.: 10/774,417 : Group Art Unit: 1792
Filed: February 10, 2004 : Examiner: Olsen, Allan W.
For: METHOD OF MAKING DIAMOND PRODUCT AND DIAMOND PRODUCT

**PETITION FOR EXERCISE OF SUPERVISORY AUTHORITY
UNDER 37 C.F.R. §1.181 AND WITHDRAWAL OF FINALITY OF OFFICE ACTION**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request that the Director exercise supervisory authority and instruct the Examiner to withdraw the improper finality of the January 9, 2008 Office Action in the above-identified application. A response to the Action is filed concurrently herewith. Withdrawal of the finality of the Office Action will allow entry of claim amendments in the response, as a matter of right and an opportunity for full reconsideration of the amended application.

A detailed explanation of the basis of this request is set forth in the remarks that follow, beginning on the next page.

REMARKS

Applicants submit that the Examiner improperly designated the Office Action dated January 9, 2008 as final. That Office Action responded to an Amendment and a Request for Continued Examination (RCE) filed October 31, 2007.

The Office Action, at page 2, asserts that "all claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected **on the grounds** and art of record in the next Office Action if they had been entered in the application prior to entry under 37 1.114."

However, the Amendment accompanying the RCE substantively amended claim 12. Although the art of record in the Office Action dated January 9, 2008 is the same, Applicants submit that the rationale or grounds for the rejection have changed.

In the Amendment, claim 12 was amended as follows:

12. (Currently Amended) A method of making a diamond product by etching a diamond substrate, said method comprising the steps of:
etching said diamond substrate using a plasma of a mixed gas, wherein the plasma of the mixed gas comprises oxygen atoms, fluorine atoms, and nitrogen atoms; and
generating a high-frequency discharge between two plate electrodes by supplying an electric power of less than 1.0 W/cm² between said plate electrodes; and
wherein the mixed gas has a fluorine atom concentration within the range of 0.04% to 6% with respect to the total number of atoms in said mixed gas.

Applicants respectfully submit that the new limitation in claim 12 necessitated a new grounds of rejection for claim 12.

Applicants therefore request that the Director exercise supervisory authority over the Examiner and withdraw the improper finality of the October 6, 2004 Office Action. As noted, an amendment of the application is filed concurrently herewith. Upon withdrawal of the finality of the last Office Action, the concurrently filed amendment should be entered as a matter of right, and prompt favorable reconsideration is solicited.

Petition Fee/Request for Refund

If required, please charge the petition fee of \$130.00 (37 C.F.R. § 1.17(h)) to Deposit Account 500417. However, in view of the impropriety of the finality, it is believed that the need for this petition arose from clear errors on the part of the Office and through no fault of Applicants. As such, Applicant respectfully request that they not be charged the petition fee, or if charged that the petition fee be refunded. If charged and refunded, the refund should be credited to said Deposit Account 500417.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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**Please recognize our Customer No. 20277
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